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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,551	06/29/2001	Kazuhiro Machiguchi	2185-0547P-P	5125

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EXAMINER

WALKE, AMANDA C

ART UNIT	PAPER NUMBER
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1752

8

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/893,551

Applicant(s)

MACHIGUCHI ET AL.

Examiner

Amanda C Walke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Claims 1 and 2 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected color filter array, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koshiha et al (4,963,463).

Koshiha et al disclose a radiation sensitive resin composition comprising a quinonediazide resin and a compound which generates an acid upon irradiation (column 2, lines 10-26). The resin may also comprise a dye, pigment, or adhesion promoter. Among the compounds listed as examples of these three types of additives is the dye Solvent Yellow 162, which is named by the present specification as a preferred example of the presently claimed

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pyridone azo dye and has a maximum absorption wavelength of 400 to 500 nm, therefore the dye meets the limitations of the present claim 3(column 6, line 59 to column 7, line 6).

Given the teachings of the reference, it would have been obvious to one of ordinary skill in the art to prepare the material of Koshiba et al. choosing to add Solvent Yellow 162 dye, with reasonable expectation of achieving a resist suitable for dry development which provides high resolution and selectivity (column 2, lines 4-9).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 3 is provisionally rejected under the judicially created doctrine of obviousness-

type double patenting as being unpatentable over claim 4 is of copending Application No.

09/893569. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the co-pending application claims a photosensitive resin comprising a pyridone azo dye having its absorption maximum at a wavelength of 400-500 nm which enables to produce a red filter layer having a transmittance of 5 % or less at 450 nm.

While the co-pending application presents the additional limitation of the specific transmittance

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(which is achieved by adding a certain specific amount of the dye to the resin), the claim of the co-pending application fully encompasses the claim limitations of the present claim 3.

Given the teachings of claim 4 of 09/893569 which fully encompass the limitations of the present claim 3, it would have been obvious to one of ordinary skill in the art to formulate the presently claimed photosensitive resin.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

7. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to teach a photosensitive resin composition wherein the amounts of the dyes, photoactive compound, and alkali-soluble resin fall within the scope of the limitations of the present claim 4, wherein the resin comprises a curing agent in an amount falling within the scope of the present claim 5, or wherein the amounts of the dyes, photoacid generator, curing agent, and the alkali-soluble resin fall within the scope of the present claim 6. The examiner performed a search of the relevant prior art, had a structure search performed by a PTO staff member, and considered the art cited as relevant in the European search report (all were "A" references), but none of the references found during the searches obviated or anticipated the present claims 4-6.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stawitz et al (5,163,971) is cited for its teachings of dyestuff mixtures of pyridone azo and metal phthalocyanine reactive dyes. The dyes are utilized in the dyeing of cotton, and fail to meet the present claim limitations for the presently claimed dye (the examiner considered the teachings in the instant specification for the structure and trade names of dyes that would meet the present claim limitations).

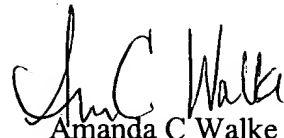
Shimomura et al (5,837,754) disclose a ink for an ink jet printer that may comprise Solvent Yellow 162. The dyes are employed in an ink rather than in a resin that includes a photopolymer as required by the instant claims. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C Walke whose telephone number is 703-305-0407. The examiner can normally be reached on M-R 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Amanda C Walke
Examiner
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ACW
July 28, 2003